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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,690	01/16/2002	Thomas C. Adams	SC 013 CIP 7	8621

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16690 Champion Forest Drive
Spring, TX 77379-7023

EXAMINER

KOHNER, MATTHEW J

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/050,690	ADAMS ET AL.	
	Examiner	Art Unit	
	Matthew J Kohner	3653	NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment / Arguments

1. Applicant has cancelled claims 1-40 and has added claims 43-60. Examiner notes that there are two claims with the number "60". For clarity the examiner will refer to the "second 60" as 61. Therefore, currently claims 41-61 are pending.

2. Applicant has argued that claims 41 and 42 define over the prior art of record because they, "require use with a deck of a vibratory separator which has an upstanding member which projects into a corresponding notch on a screen assembly placed on the deck (Applicant's remarks page 6, lines 29+)."

In light of applicant's arguments, examiner agrees that Baltzer does not disclose an upstanding member as claimed in claims 41 and 42. Therefore, these claims appear to define over Baltzer.

However, claims 41 and 42 are method claims and yet **it is the structure contained within one of the steps of the method claim** which defines over the prior art. Therefore, claims 41 and 42 appear to contain a product and a process for using that product in the same claim, which is impermissible. MPEP 2173.05(p) addresses this situation.

2173.05(p) Claim Directed to Product-By- Process or Product and Process

II. PRODUCT AND PROCESS IN THE SAME CLAIM

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under 35 U.S.C. 112, second paragraph.

Art Unit: 3653

Such claims should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551.

Therefore, applicant’s 41 and 42 are rejected under 35 U.S.C. 112, second paragraph and 35 U.S.C. 101.

3. Applicant argues that claims 43-60 define over the prior art because they require that the non-flat areas of screen material are rippled. However, independent claims 43 and 57 are method claims. Method claims are examined based on the steps that comprise them. Here, the method for using a screen assembly basically comprises the steps of:

- Mounting the screen assembly on a vibratory separator
- Vibrating the screen assembly on the vibratory separator
- Feeding material to be treated onto the screen assembly for such a period of time as to

effect flattening of the screen.

The fact that the preamble of the claim recites the intended use of the method (i.e. that the method is to be used with screens which have non-flat areas comprised of rippled areas of screening material between the lines of glue) is not given patentable weight. As long as the prior art is capable of performing the method, it anticipates the claim. Here, Baltzer teaches all the steps of this method. Baltzer teaches a method for using a screen assembly on a vibratory separator which includes:

- Mounting the screen assembly on a vibratory separator
- Vibrating the screen assembly on the vibratory separator

Art Unit: 3653

- Feeding material to be treated onto the screen assembly for such a period of time as to effect flattening of the screen.

Therefore, Baltzer anticipates the independent claims.

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 60 has been renumbered 61.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42, 43, 54 and 61 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 42, 43, 54 and 61, each claim both an apparatus and the method steps of using the apparatus. Therefore, they are indefinite.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Art Unit: 3653

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 42, 43, 54 and 61 are rejected under 35 U.S.C. 101 because they are directed to neither a "process" not a "machine" but rather embrace and overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted to set forth the statutory classes of invention in the alternative only.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-53 and 55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,967,336 to Baltzer et al.

Baltzer discloses a method for using a screen assembly on a vibratory separator, the screen assembly having non-flat areas of screening material thereon, the non-flat areas of screening material between lines of glue,

- gluing together a plurality of layers of screening material (Col. 1, lines 50+),
- the plurality of glued-together layers of screening material secured to a frame (Col. 1, lines 52+), the frame comprising:

Art Unit: 3653

two ends (18 and 20), each end connected to and spaced-apart by one of two spaced-apart sides (14 and 16), the two spaced-apart sides including a first side and a second side and the frame including

a plurality of spaced-apart cross-members (40,42,44,46,48,50), each cross-member extending from the first side to the second side,

the method comprising:

- mounting the screen assembly on a vibratory separator (Col. 1, lines 15+), the vibratory separator located in an environment at an ambient temperature,
- vibrating the screen assembly with the vibratory separator for a period of time (Col. 1, lines 15+),
- feeding material to be treated onto the screen assembly (Col. 1, lines 15+).

Baltzer does not specifically disclose the temperature of the material to be treated, nor the period of time the material is on the screen assembly. However, Examiner notes that the limitation of claim 43 wherein, “the period of time of such a temporal length and the material temperature of such a temperature to effect flattening of the non flat areas of screening material” is very broad. Further, it would be obvious to one of ordinary skill in the art that known shale shakers such as Baltzer et al. would vibrate the drilling mud at such a temperature for such a period of time.

In regard to claims 44-45, it is well known in the art that drilling mud can reach temperatures of several hundred degrees (See attached paper¹ especially Fig. 5).

¹ Prediction of Formation Equilibrium Temperature while Drilling based on Drilling Mud Temperature: Inverse Problem using Trough2 and Wellbore Thermal Model.

In regard to claims 46 and 59, Baltzer discloses that the vibrating shakers are used at oil well drilling sites (Col. 1, lines 27+) and that the mixture of materials is fed on the top of the screen assembly (Col. 1, lines 18+).

In regard to claims 47, 48 and 58, Baltzer does not disclose using cured moisture-curing hot melt glue to glue together the plurality of layers of screening material. Rather, Baltzer discloses using epoxy (Col. 2, lines 55+). It would be obvious to one of ordinary skill in that art to use another adhesive such as glue to secure the plurality of layers together. Examiner notes that applicant has argued that “[m]oisture-curing hot melt glue is different from such epoxies in both structure, use, and in results achieved in a screen assembly.” However, Examiner does not contend that the glue and epoxy are the same. Examiner merely contends that the use of the moisture curing hot melt glue would be obvious to one of ordinary skill in the art in light of the teachings of Baltzer.

Further, the limitation of the glue being “applied in a pattern” is very broad and is not further defined in the specification. Baltzer does not specifically disclose how the epoxy is applied. However, it would be obvious to one of ordinary skill in the art that the adhesive could be applied in a particular, replicable, way (i.e. a pattern) rather than just merely applying adhesive haphazardly and differently in each screen produced.

In regard to claims 50-53, Baltzer discloses that the plurality of layers is secured to the frame by glue or *other adhesives* (Col. 2, lines 57+).

In regard to claims 55-56, Baltzer does not specifically disclose that the plurality of layers include at least a lower layer of coarse mesh and at least one layer of fine mesh. Instead, Baltzer merely discloses a multiple layers of wire screen cloth (Col. 1, lines 50+). However, it is

Art Unit: 3653

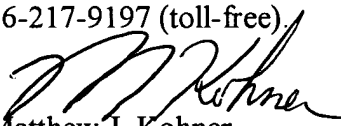
well known in the art to use at least a lower layer of coarse mesh and at least one layer of fine mesh (See e.g. US Patent No. 5,417,793 to Bakula, Col. 9, lines 1-15).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kohner whose telephone number is 703-305-8496. The examiner can normally be reached on Mon-Fri 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew J. Kohner
Examiner
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